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REMARKS

Claims 24-45 and 48-50 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

Applicants would like to thank the Examiner and the Examiner's supervisor for taking the time for a telephonic interview on November 12, 2009. In the interview, the combination of U.S. Patent No. 5,350,063 to Berdan, II in view of U.S. Patent No. 7,041,353 to Smith et al. was discussed. As set out by Applicants, a proper combination of these references would not result in the subject matter of the claims, but would result in the subject matter as disclosed in U.S. Patent No. 4,555,017 to Blackmore as set forth in the previous response and as outlined below. During the interview, the Examiner's supervisor stated that the rejection of the claims over the Berdan, II '063 patent in view of the Smith et al. '353 patent may be wrong, but the claims are nonetheless not patentable. Accordingly, Applicants request the Examiner to specifically address the arguments made in the response below as to why a combination of the references as cited by the Office Action would not result in the package of the Blackmore '017 patent but would result in the package as claimed. Alternatively, if the claims are rejected over other references or in another manner, Applicants would like such rejection. Applicants would appreciate if this record could be complete in case an appeal is necessary after a further rejection. Claim 36 was also discussed and Applicant submits that the references cited in the Office Action to reject claim 36 do not include all of the features of claim 36 as outlined below.

Claims 24-26, 34, 35, 37, 39, 40 and 45 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,350,063 to Berdan, II in view of U.S. Patent No. 7,041,353 to Smith et al. As further discussed below, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The test for obviousness has recently been addressed by the U.S. Supreme Court in *KSR Int'l. Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (2007). In its decision, the Supreme Court stated that the teaching-suggestion-motivation (TSM) standard developed by the Federal Circuit was no longer the sole test for determining obviousness. Nevertheless, the Court indicated that the TSM test provides helpful insights as to the obviousness of the invention.

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Furthermore, according to M.P.E.P. §2142:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Applicants submit that the Office Action has not clearly articulated the reasons why the claimed invention would have been obvious.

Moreover, while the U.S. Supreme Court held that the TSM standard was not the sole standard for finding obviousness, there is at least one element to the finding of a *prima facie* case of obviousness that is common to both the TSM standard and the standards that may otherwise fall within the purview of the *KSR* decision. Specifically, each and every element of the claimed invention must still be considered. As will be set forth below, there are elements of the claimed invention that are missing in their entirety from the cited prior art.

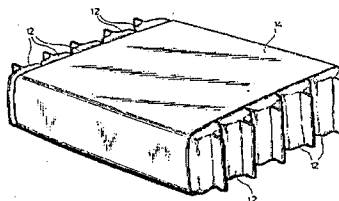
Claim 24 defines a large package for the transport and storage of insulation components comprising modules arranged side by side, each module comprising a plurality of insulation elements combined by a film covering. The modules are tied by wrapping elements to form a storage and transport unit and are entirely protected against water ingress by a waterproof covering completely encasing the modules. Each module comprises several insulation rolls or insulation panel packets and the insulation rolls or insulation panel packets are arranged in one layer adjacent to each other.

Applicant submits that the above-noted features of claim 24 are not obvious over the cited art of record. The Berdan, II '063 patent discloses a cartwheelable shipping package for insulation. The package of the Berdan, II '063 patent includes insulation batts 10 surrounded by a wrapper 16, a plurality of the wrappers 16 that can be enclosed by a sleeve 20, and that a number of the sleeves 20 can be bound using bands 30 or another sleeve 26. The Smith et al.

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'353 patent includes insulation batts 24 and 26 covered by a covering 12 (equivalent to the wrapper 16 of the Berdan, II '063 patent). Applicants submit that any combination of the Berdan, II '063 patent with the Smith et al. '353 patent would result in the insulation batts 10 being covered with a covering 12 of the Smith et al. '353 patent. However, the sleeve 20 and the sleeve 26 or the bands 30 of the Berdan, II '063 patent would remain the same. In other words, the resulting combination would be the package as disclosed in U.S. Patent No. 4,555,017 to Blackmore as illustrated below:

United States Patent [19]		[11] Patent Number:	4,555,017
Blackmore		[45] Date of Patent:	Nov. 26, 1988
[54] BALES OF BAGGED BATTES		2,216,445 4/1966	Elmstrom 106/732
[75] Inventor: Timothy W. Blackmore, Canby, Ore.		2,337,449 6/1977	Harlow et al. 306/713
[73] Assignee: Fibershield Canada Inc., Toronto, Canada		2,432,976 6/1979	David et al. 306/713
[21] Appl. No.: 877,261		2,516,317 6/1979	Gilbertson 306/499
[22] Filed: Dec. 3, 1984		2,683,092 6/1979	David et al. 306/499
Related U.S. Application Data		2,742,741 7/1979	Harlow et al. 306/713
[63] Continuation-in-part of Ser. No. 535,846, Nov. 28, 1983		2,754,091 7/1979	David 306/713
[30] Foreign Application Priority Data		Primary Examiner—William T. Dwyer, Jr. Attorney Agent or Firm—Robert F. Dehnbright Assoc. I. P.C.	
Sep. 14, 1983 (CA) Canada 416028		[57] ABSTRACT	
[31] Int. Cl. B65D 88/14; B65D 85/52; B65D 91/06		A bale of elongated flexible bags of generally rectangular section each containing one or more batts of fibrous heat insulating material, the bags being aligned in a row with larger faces in mutual contact. A sleeve of flexible relatively non-stretchable material having a width which is a substantial proportion of the length of the batts extends around the row of bags and retains the fibrous heat insulating material in a compressed state in which the uncompressed volume of the heat insulating material is reduced but which results in substantially full recovery to the uncompressed volume when the heat insulating material is removed from the bags after the wrapping sleeve has been removed.	
[32] U.S. Cl. 206/455; 206/449; 206/451; 206/460		4 Claims, 1 Drawing Figure	
[58] Field of Search 206/437, 321, 525, 206/439, 385, 449, 524.8, 45-33, 233, 239/40			
[59] References Cited			
U.S. PATENT DOCUMENTS			
2,254,118 7/1964 Dwyer 306/721			
2,912,090 11/1959 Fisher 306/524			



Therefore, a combination of the Berdan, II '063 patent with the Smith et al. '353 patent would not result in a plurality of insulation elements combined by a film covering to form a module, with the modules being entirely protected against water ingress by a waterproof covering completely encasing the modules as claimed in claim 24 along with the remaining features of claim 24. Any resulting combination of the Berdan, II '063 patent with the Smith et al. '353 patent would not include a covering completely encasing modules. Accordingly, claim 24 is in condition for allowance.

Claims 25, 26, 34, 35, 37, 39, 40 and 45 depend from claim 24, and since claim 24 defines unobvious patentable subject matter as discussed above, claims 25, 26, 34, 35, 37, 39,

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40 and 45 define patentable subject matter. Furthermore, in regard to claim 40, Applicants submit that the combination does not further include modules held together by retainers in addition to the film covering and the waterproof covering as claimed. Applicants note that the straps 18 of the Smith et al. '353 patent are not part of a combination of the references as set forth in the Office Action. Accordingly, claims 25, 26, 34, 35, 37, 39, 40 and 45 are in condition for allowance.

Claims 27-31, 43 and 48 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the Berdan, II '063 patent in view of the Smith et al. '353 patent and U.S. Patent No. 3,681,092 to Titchenal. Claims 27-31 and 43 depend from claim 24 and since claim 24 defines patentable subject matter as discussed above, claims 27-31 and 43 define patentable subject matter. Furthermore, Applicants submit that it is not obvious to protect fresh meat with packaging specifically designed to protect insulation. The items within the packages, namely insulation and fresh meat, require specific materials for their packaging and it is not obvious to use packaging for one of these items to package the other item. In summation, Applicants submit that it is not obvious to combine the references as set forth in the Office Action. Accordingly, claims 27-31, 43 and 48 are in condition for allowance.

Furthermore, claim 48 defines a method of transporting and using insulation elements comprising providing a module for the transport and storage of the insulation elements, covering the module with a waterproof covering, with the module being protected in its entirety against water ingress by the waterproof covering that completely encases the module and disposing of the waterproof covering by using the waterproof covering as a vapor barrier for a high-pitched roof.

According to the Office Action, the step of using the waterproof covering as a vapor barrier for a high-pitch roof is a matter of design choice and does not disclose any structural limitation. However, claim 48 is a method claim and claim 48 clearly includes a method step, namely using a waterproof covering as a vapor barrier, and structure, namely a waterproof covering used as a vapor barrier on a high-pitch roof. Accordingly, claim 48 requires a waterproof covering and a high-pitch roof. None of the cited art of record discloses any such structure or any such step. Therefore, claim 48 is clearly in condition for allowance.

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Claims 32 and 33 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the Berdan, II '063 patent in view of the Smith et al. '353 patent and U.S. Patent No. 6,471,061 to Teague et al. Claim 32 states that at least two of the modules are arranged alternatively upright and lying flat and claim 33 states that the modules are arranged upright but offset relative to each other. Applicants submit that the Teague et al. '061 patent does not disclose both the subject matter of claims 32 and 33 and the subject matter of claims 32 and 33 are mutually exclusive. Accordingly, the combination of the references as set forth in the Office Action cannot include the subject matter of both claims 32 or 33. Accordingly, Applicant submits that at least one of these claims are in condition for allowance.

Claim 36 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Berdan, II '063 patent in view of the Smith et al. '353 patent in view of U.S. Patent No. 5,417,040 to Davoren or U.S. Patent No. 6,326,069 to Barnett et al. Claim 36 depends from claim 24, and further states that the waterproof covering is composed of film which is self-adhesive in an overlap area and which attaches to itself on making contact, without additionally requiring an adhesive. First, claim 36 depends from claim 24, and since claim 24 defines patentable subject matter as discussed above, claim 36 defines patentable subject matter. Second, Applicant notes that the Barnett et al. '069 patent discloses use of an adhesive and the Davoren '040 patent only discloses use of an adhesive for strips bonded to a bag. See lines 57-61 of column 2 of the Davoren '040 patent. Accordingly, neither of these patents disclose a film which is self-adhesive and which attaches to itself on making contact without additionally requiring an adhesive. Both of these cited references either require an item attached to a film such that the film does not attach to itself and is not self-adhesive. Accordingly, claim 36 is in condition for allowance.

Claim 38 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Berdan, II '063 patent in view of the Smith et al. '353 patent in view of German Reference No. DE9117214. Claim 38 depends from claim 24 and is in condition for allowance along with claim 24.

Claims 41 and 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the Berdan, II '063 patent in view of the Smith et al. '353 patent and U.S. Patent No.

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5,873,460 to Reinhardt. Claims 41 and 42 depend from claims 24 and 40, and since claims 24 and 40 define patentable subject matter as discussed above, claims 41 and 42 define patentable subject matter. Accordingly, claims 41 and 42 are in condition for allowance.

Claim 44 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Berdan, II '063 patent in view of the Smith et al. '353 patent and U.S. Patent No. 4,535,587 to Rias. Claim 44 depends from claim 24, and since claim 24 defines patentable subject matter as discussed above, claim 44 defines patentable subject matter. Accordingly, claim 44 is in condition for allowance.

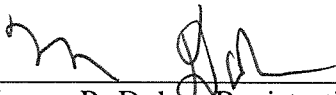
New claim 50 is believed to define patentable subject matter.

All pending claims 24-46, 48 and 50 are in condition for allowance and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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Date



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